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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/653,699	09/02/2003	David J. Brown	213828013US4	3482
25096	7590	09/30/2004	EXAMINER	
PERKINS COIE LLP			LE, UYEN CHAU N	
PATENT-SEA			ART UNIT	
P.O. BOX 1247			PAPER NUMBER	
SEATTLE, WA 98111-1247			2876	

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/653,699

Applicant(s)

BROWN ET AL.

Examiner

Uyen-Chau N. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-12 and 22-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-12 and 22-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/03, 12/03, 2/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prelim. Amdt/Amendment

1. Receipt is acknowledged of the Preliminary Amendment filed 02 September 2003.

Claim Objections

2. Claim 22 is objected to because of the following informalities:

Re claim 22, line 9: Substitute "it" with -- the third indicia --.

Appropriate correction is required.

Obviousness-Type Double Patenting

3. Claims 8-12 and 22-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 8-10, 13 and 17-21 of U.S. Patent No. 6,644,696 (hereinafter '696).

Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 8-12 and 22-23 of the instant application, Applicants claim a voucher configured to assist in **distinguishing unauthorized duplicate or counterfeit** vouchers, the voucher comprising "a **substrate**", "a **first indicia** on the substrate", "a **thermally responsive second indicia** on the substrate, at least one of the first indicia and second indicia **indicating a value of the voucher**", "a plurality of **perforations** in the substrate defining a pattern", "the thermally responsive second indicia includes **thermo-chromic ink**", "the thermally responsive second indicia has an **activation temperature of at least 75 degrees**

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Fahrenheit”, “ a third indicia on the substrate, the **third indicia** being at least **partially obscured** by the thermally responsive second indicia”, ... and “a substantially **non-visible mark** on the substrate, wherein **rubbing** adjacent to the mark with an object will **render the mark visible**”.

The ‘696 patent discloses a method for **providing a voucher**, ... with the voucher configured to assist in **distinguishing unauthorized duplicate or counterfeit** vouchers, the method comprising, among other things, “a **substrate**”, “a **first indicia** containing an indication of a **value of the voucher**”, “a plurality of **perforations** in the substrate ...”, “the **third indicia** being at least **partially obscured** the thermally responsive second indicia”, “the thermally responsive second indicia includes **thermo-chromic ink**”, “the thermally responsive second indicia has an **activation temperature of at least 75 degrees Fahrenheit**”,... and “a substantially **non-visible mark** on the substrate, wherein **rubbing** adjacent to the mark with an object will **render the mark visible**”. Although the scope of claims 8-12 and 22-23 of the present application and claims 1, 6, 8-10, 13 and 17-21 of ‘696 patent are almost identical, the difference between the present claimed invention and the ‘696 patent is that the present claimed invention is a broader recitation of the ‘696 patent (e.g., the present claimed invention recites “a plurality of **perforations** in the substrate defining a pattern, etc.” whereby the ‘696 patent recites “a plurality of **perforations** in the substrate to define a **curved** pattern of perforations, etc.”). Thus, with respect to above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teaching of claims 1, 6, 8-10, 13 and 17-21 of ‘696 patent as a general teaching for having a **voucher** with the same functions as claimed by the present application. The instant claims obviously encompass the patented claims and differ only in terminology. To the extent that the instant claim is broaden and therefore generic to the

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patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

The obviousness-type double patenting rejection is a judicially established doctrine base upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R § 1.78(d).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 25-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Holmes (GB 2,326,866 A).

Re claims 25-28: Holmes discloses a substrate (e.g., a label) including at least a thermally responsive substrate portion (e.g., a layer of a thermo-chromic ink), the thermally responsive substrate portion having a first visual appearance at a first temperature and a second visual

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appearance at a second temperature (p. 2, last paragraph; p. 3, 2nd paragraph), and an indicia (e.g., a logo) on the substrate (p. 4, 6th paragraph); wherein the first visual appearance (e.g., no color) of the thermally responsive substrate portion is lighter than the second visual appearance (e.g., full color) of the thermally responsive substrate portion, and wherein the second temperature (e.g., 32-40⁰C) is higher than the first temperature (e.g., room temperature) (p. 3, last paragraph and p. 5, 1st paragraph); wherein the first visual appearance (e.g., full color) substrate portion is darker than the second visual appearance (e.g., loses color) of the thermally responsive substrate portion, and wherein the second temperature (e.g., 41-50⁰C) is higher than the first temperature (e.g., 32-40⁰C) (p. 5, 1st paragraph); wherein the indicia/logo is positioned adjacent to the thermally responsive substrate portion (p. 4, last paragraph).

Re claim 29, Holmes discloses a substrate (e.g., a label), a first indicia on the substrate/label, and a second indicia (e.g., a layer overlaps the indicia) on the substrate/label, the second indicia having a first visual appearance at a first temperature and a second visual appearance at a second temperature, wherein one of the first visual appearance or the second visual appearance is a visible appearance and the other visual appearance is a non-visible appearance (e.g., disappeared) (p. 3, 3rd paragraph).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 8-11 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beach et al (US 6,116,402) in view of Holmes. The teachings of Holmes have been discussed above.

Re claims 8-11 and 30-31: Beach et al discloses a voucher configured to assist in distinguishing unauthorized duplicate or counterfeit vouchers, the voucher comprising: a flexible and elongate substrate (fig. 1) in connection with a coin counting machine and configured to receive a first indicia 124a on the substrate; a second indicia 124b on the substrate; the coin counting machine provides a total value related to a plurality of randomly received coins (fig. 1); at least one of the first indicia 124a and second indicia 124b indicating a value of the voucher (fig. 1; col. 4, lines 17-39); a third indicia (e.g., 217.93) on the substrate, the third indicia being at least partially obscured by the second indicia (fig. 1).

Beach et al fails to teach or fairly suggest the second indicia includes thermo-chromic ink, which is thermally responsive; wherein the thermally responsive second indicia has an activation temperature of at least 75 degrees Fahrenheit; respectively.

Holmes teaches advertising indicia defined by thermo-chromic ink, which is thermal responsive indicia (abstract, lines 1-8); wherein the indicia changes color at a temperature of at least 75⁰F (see table 1, page 6).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Holmes into the system as taught by Beach et al in order to provide Beach et al with a more secure system wherein the indicia made difficult to copy, duplicate due to the thermal responsive ink. Furthermore, such modification would assist in distinguishing counterfeit vouchers due to the color changing of the indicia upon changing the temperature, and therefore an obvious expedient.

9. Claims 8-10, 12 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hulleman (EP 1,127,593 A1) in view of Holmes. The teachings of Holmes have been discussed above.

Re claims 8-10, 12 and 22-24: Hulleman discloses a voucher 1 configured to assist in distinguishing unauthorized duplicate or counterfeit vouchers, the voucher 1 comprising: a substrate (fig. 1); a first indicia 5 on the substrate indicating a value of the voucher 1 (fig. 1); a second indicia 19 on the substrate; a plurality of perforations in the substrate defining a pattern (e.g., a dashed line where a coupon 7 being torn-off); a substantially non-visible mark 17 on the substrate, wherein rubbing adjacent to the mark with an object will render the mark visible (col. 4, lines 14+).

Hulleman fails to teach or fairly suggest the second indicia includes thermo-chromic ink, which is thermally responsive; wherein the thermally responsive second indicia has an activation temperature of at least 75 degrees Fahrenheit; respectively.

Holmes teaches advertising indicia defined by thermo-chromic ink, which is thermal responsive indicia (abstract, lines 1-8); wherein the indicia changes color at a temperature of at least 75⁰F (see table 1, page 6).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Holmes into the system as taught by Hulleman in order to provide Hulleman with a more secure system wherein the indicia made difficult to copy, duplicate due to the thermal responsive ink. Furthermore, such modification would assist in distinguishing counterfeit vouchers due to the color changing of the indicia upon changing the temperature (i.e., the operator has the ability to verify the authorization of the voucher/coupon by verifying the changed color(s) of the indicia at different temperatures), and therefore an obvious expedient.

Remarks

10. It has been noted by the Examiner that WO 95/30215 A, and U.S. Patent No. 5,598,477 references were cited as "Y" reference in the PCT/EP99/955153 dated 22 October 2003.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents Puckett et al. (US 5466012 A); Principe et al. (US 5413384 A); Salvatore (US 5002313 A); Clapper (US 6056289 A); Frankel (US 5375271 A); Howes (US 5785171 A);

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Scrymgeour et al. (US 5083815 A) to are cited as of interest and illustrate to a similar structure of a voucher anti-counterfeiting method and apparatus.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397.

The examiner can normally be reached on Mon, Wed. and Fri. 5:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Uyen-Chau N. Le

September 20, 2004